

REMARKS

This amendment after final rejection should be entered because it places the claims and the application in better form for consideration on appeal and amends the specification to comply with format requirements from the PTO. *See* 37 C.F.R. §1.116.

It is respectfully requested that the next PTO Action acknowledge the information disclosure statement filed on July 27, 2001. An initialed copy of the Form PTO 1449 is respectfully requested to be returned in the next PTO Action.

The undersigned attorney has been recently assigned to this application and the application has been transferred to the law firm of Nixon & Vanderhye. Confirmation that future USPTO correspondence is to be directed to Nixon & Vanderhye is respectfully requested.

The rejection of claims of 11 to 14 as being directed to non-statutory subject matter is traversed. The rejection does not provide an explanation as to why printed matter with a verification mark, such as a “digital signature”, is non-statutory subject matter. Further, claims 11 to 14 have been amended to require the goods to have public data and a security code applied thereto. Goods marked with public data and a security code are statutory patentable subject matter.

The claims have been amended to use the term “public data” to be consistent with the original claims and the specification which also use “public data.” The term “public plain text” added by the last amendment has been removed from the claims.

The rejection of claims 7 and 11 as being anticipated by Coppersmith (U.S. Patent No. 6,069,955) is traversed and overcome by amendment. Independent claims 7 and 11 have been amended to require the security code to be generated by encrypting both public data applied to the goods and one of a plurality of private data sets.

Encryption of both public and private data is disclosed at, for example, the paragraph bridging pages 5 and 6 of the specification which makes clear that both private data and the public data is subjected to an encryption process. The specification discloses a one way hash function to encrypt the public data and private data to generate the security code to be printed on the goods. The use of a one way hash function makes clear that neither the public data nor the private data act as an encryption key. One way hash functions do not require keys.

To verify goods, the public data from the goods and private data from one of a plurality of private data sets held by a verifier are encrypted with the same encryption algorithm, e.g., the one-way hash function, to generate a listing of verification codes. Spec. p. 6. The verification codes are compared to the security code from the goods to verify the authenticity of the goods. Spec. p. 6.

Coppersmith teaches applying to goods a plain text serial number and a private/public key encrypted serial number. In Coopersmith, only the serial number is encrypted. Coopersmith also uses keys for encryption, and does not teach encrypting the public or private keys.

The rejection is based, in part, on the invalid assumption that the public and private data of the claims are similar to the public and private keys of Coppersmith. The current invention need not rely on encryption keys. Further, the assumption underlying the rejection is not tenable given that independent claims 7 and 11 require that both the public data and the private data be encrypted. In method of claims 7 and 11, both the public data and the private data are subject to an encryption process, and neither the public data nor the private data acts as an encryption key. Thus, the methods of claims 7 and 11 are substantially different than the public/private key system disclosed in Coppersmith.

Furthermore, the private data of the claims is not the same as the private key of Coppersmith because claims 7 and 11 require the private data sets to be held by a verifier. In the system of Coppersmith, the verifier holds only the public key and the private data is known only to the encrypter, not the verifier.

The rejection of claims 1, 3 to 14 as being obvious over Coppersmith in view of Nagata (U.S. Reissued Patent No. 32,985) is traversed for the same reasons as stated above made with respect to independent claims 7 and 11 (on which depend claims 8 to 10 and 12 to 14).

Claim 1 (on which depends claims 3 to 6) includes a limitation for a “security code having been derived by encrypting said public data applied to the goods and one of a plurality of private data.” This requirement of claim 1 distinguishes Coppersmith which (as stated above) does not teach encrypting “private data.” Further, Claim 1 is a method of “verifying the authenticity of goods” and includes the step of “comparing said security code applied to the goods with said list of verification codes to assess the authenticity of goods” where the verification codes are “held by a verifier.” This step of claim 1 distinguishes Coppersmith which (as stated above) does not teach verification codes held by the verifier.

Claim 1 has been further amended to make more clear that it recites method steps carried out at verification time. The claims steps of method claim 1 are not the steps carried out at marking time.

In view of the disclosure of Coppersmith, the invention of claim 1 offers numerous benefits by encrypting not only public data applied to the goods (as contemplated by Coppersmith) but also encrypting one of a plurality of private data sets known both to the encrypter and the verifier.

The credit transaction processing system disclosed in Nagata does not suggest that Coppersmith be modified to form the claimed invention. Accordingly, the rejection for obviousness should be withdrawn for the same reasons that the rejection for anticipation should be withdrawn.

The rejection of dependent claim 2 for obviousness in view of Coppersmith, Nagata and Tran is traversed for the same reasons as stated above for claim 1 on which claim 2 depends.

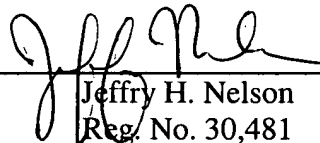
In any event, it is respectfully submitted that one of skill in the art would not be motivated to consider Tran, given that it relates to a different technical field (i.e. the field of verifying user log-on details, not verifying the authenticity of goods.) Furthermore, the audit log taught by Tran for auditing log on operations is in no way comparable to the log of claim 2 which is used for verification purposes in assessing the authenticity of goods.

All claims are in good condition for allowance. If any small matter remains outstanding, the Examiner is requested to telephone applicants' attorney. Prompt reconsideration and allowance of this application is requested.

Respectfully submitted,

NIXON & VANDERHYE P.C.

By: _____


Jeffrey H. Nelson
Reg. No. 30,481

JHN:glf
901 North Glebe Road, 11th Floor
Arlington, VA 22203-1808
Telephone: (703) 816-4000
Facsimile: (703) 816-4100